

REMARKS

Claims 1 – 11 and 25 Are Allowable

The Office Action rejected Claim 1 as obvious based on *Nolting et al.* in view of *Lesley*. Respectfully, the Office Action erred.

In sum, *Nolting et al.* fails to teach or suggest at least two of Claim 1's actions: (1) receipt billing information from a set activation fee pay telephone; and (2) charging the set activation fee for the telephone call. Further, *Nolting et al.* and *Lesley* cannot be combined because at least the "billing information" is different and not interchangeable between the two references. Therefore, the rejection of Claim 1 based on *Nolting et al.* in view of *Lesley* is respectfully requested to be withdrawn.

More particularly, the first action of Claim 1 states:

"receiving billing information from a set activation fee pay telephone, the set activation fee pay telephone associated with an originating telephone number;"

The Office Action stated this action is taught at *Nolting et al.*, col. 30, lines 10-19. The Office Action does not explain how *Nolting et al.* teaches this action. Particularly, the Office Action leaves unexplained what element(s) in *Nolting et al.* constitute the "billing information" of Claim 1.

Contrary to its assertion, the Office Action's reference to *Nolting et al.* does not teach nor suggest the receipt of billing information. Rather, *Nolting et al.* refers to the recording of calls in a billing system. Specifically, *Nolting et al.* refers to the recording of calls in a billing system so a local exchange carrier (LEC) may recoup previously lost revenue. The recording of such calls may result from analysis provided by the traffic track system described in *Nolting et al.* The recording of calls in a billing system does not constitute receipt of billing

information as used in Claim 1. Thus, *Nolting et al.* fails to teach or suggest the receipt of billing information.

As noted above, the first action of Claim 1 includes “receiving billing information from a set activation fee pay telephone.” As also noted above, *Nolting et al.* does not receive billing information, and in particular does not receive billing information from a set activation fee pay telephone.

Even if the recording of calls in a billing system is considered “billing information” (for purposes of argument only), then *Nolting et al.* still fails to teach or suggest the first action of Claim 1. The information related to the recording of calls in a billing system is not received by *Nolting et al.* from a set activation fee pay telephone. Rather, *Nolting et al.* receives call records “from certain management data messages used by the network.” *Nolting et al.*, col. 5, lines 49-50. Thus, *Nolting et al.* fails to teach or suggest the receipt of billing information.

Another action of Claim 1 states:

“determining whether the billing information is valid;”

The Office Action acknowledged *Nolting et al.* fails to teach this action. The Office Action stated this action is taught in *Lesley*, and it would have been obvious to combine the teachings of *Lesley* and *Nolting et al.* to teach the subject matter of Claim 1. Respectfully, the Office Action erred. As explained above, *Nolting et al.* does not teach “billing information” nor “receiving billing information from a set activation fee pay telephone” as set forth in Claim 1. Therefore, the combination of *Lesley* and *Nolting et al.* does not teach nor suggest the subject matter of Claim 1.

Moreover, even if *Nolting et al.* is accepted as teaching “billing information” (for purposes of argument only), then *Nolting et al.*’s combination

with *Lesley* still does not teach the subject matter of Claim 1. The cited references cannot be combined as set out in the Office Action at least because the “billing information” in *Nolting et al.* is different from the “billing information” in *Lesley*.

For purposes of argument only, even if *Nolting et al.*’s recording of calls in a billing system is considered “billing information”, it is not the same as the billing information in *Lesley* and cannot be substituted for *Lesley*’s billing information (or vice versa). In *Lesley*, the “billing information” is the account number (either a subscriber account number or prepay account number) entered by the subscriber in making a call to a prepaid telecommunications service. *Lesley*, col. 8, lines 3-10. *Lesley*’s billing information does not substitute for *Nolting et al.*’s billing information and vice versa. Thus, *Nolting et al.* fails to teach or suggest the receipt of billing information.

Claim 1 includes the following as its last action:

“based on the identification, charging the set activation fee for the telephone call regardless of the telephone number.”

The Office Action erroneously found this action in *Nolting et al.*, col. 30, lines 10-39. Yet, there is no mention of charging a set activation fee in *Nolting et al.* Rather, in response to finding a telephone number is used to make calls to a prepaid calling card service, *Nolting et al.* explains that network elements and the billing system then have to be reconfigured so as to measure calls from that telephone number.

“To recapture the revenues, the LEC then modifies the switches, and billing system to measure those calls to such numbers, which were from coin phones, even if under 30 or 40 seconds.”

Nolting et al., col. 30, lines 36-39. No mention is made of the action of charging the set activation fee for the telephone call. Thus, *Nolting et al.* fails to teach or suggest the charging action of Claim 1.

In sum, *Nolting et al.* fails to teach or suggest at least two of Claim 1's actions: (1) receipt billing information from a set activation fee pay telephone; and (2) charging the set activation fee for the telephone call. Further, *Nolting et al.* and *Lesley* cannot be combined because at least the "billing information" is different and not interchangeable between the two references. Therefore, the rejection of Claim 1 based on *Nolting et al.* in view of *Lesley* is respectfully requested to be withdrawn.

Claims 2-7 depend on Claim 1. The arguments made with respect to Claim 1 are applicable to the dependent claims. Therefore, the rejections of Claims 2-7 based on *Nolting et al.* in view of *Lesley* are respectfully requested to be withdrawn.

Claim 8 is an independent claim. The arguments made regarding Claim 1 are applicable to Claim 8. In addition, Claim 8 includes the following underlined limitation in the "charging action":

"charging a set activation fee to the caller at the termination of the telephone call regardless of the telephone number."

The Office Action claims this action is taught by *Nolting et al.* Yet, there is no mention of charging a set activation fee in *Nolting et al.* Rather, *Nolting et al.* explains that network elements and the billing system then have to be reconfigured so as to measure calls from that telephone number.

If network elements and the billing system have to be reconfigured to measure calls from that telephone number, then *Nolting et al.* cannot charge a set activation fee at the termination of the telephone call. *Nolting et al.* cannot charge the set activation fee at the termination of the telephone call because the

network elements and billing system that would be used to make such a charge have not been reconfigured at the time of the termination of the telephone call. Therefore, the rejection of Claim 8 based on *Nolting et al.* in view of *Lesley* is respectfully requested to be withdrawn.

Claims 9-11 depend on Claim 8. The arguments made with respect to Claim 8 are applicable to the dependent claims. Therefore, the rejections of Claims 9-11 based on *Nolting et al.* in view of *Lesley* are respectfully requested to be withdrawn.

Claim 25 was erroneously rejected together with Claims 1 – 11. At least for the reasons set forth above, Claim 25 is allowable.

Claims 12 – 17 Are Allowable

Independent Claim 12 was erroneously rejected primarily for the same reasons that independent Claims 1 and 8 were erroneously rejected. At least for the reasons described above, Claim 12 and its dependent claims (Claims 13 – 17) are allowable.

Claims 18 – 22 Are Allowable

Claims 18 – 22 were erroneously rejected as obvious in light of *Golden*, United States Patent 4,897,970 in view of *Nolting et al.* Independent Claim 18 was erroneously rejected primarily for the same reasons that independent Claims 1 and 8 were erroneously rejected. At least for the reasons described above, Claim 18 and its dependent claims (Claims 19-22) are allowable.

Claims 23 - 24 Are Allowable

Independent Claim 23 was erroneously rejected primarily for the same reason that Claims 1 and 8 were erroneously rejected. At least for the reasons described above, Claim 23 and its dependent claims are allowable.

CONCLUSION

Failure to Set Forth Prima Facie Obviousness Rejections

The Office Action rejected all of the claims, but Claims 23-24 for alleged obviousness. Yet, the Office Action failed to establish a *prima facie* case of obviousness regarding the claimed subject matter. Three basic criteria have to be met for a prima facie case of obviousness:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) There must be a reasonable expectation of success; and
- (3) The cited references must teach or suggest all of the claim limitations.

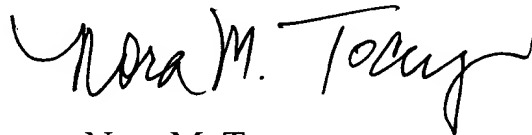
With respect to the claims rejected for alleged obviousness, the Office Action failed to satisfy at least the first criterion. The Office Action failed to point to suggestions or motivations, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The statements in the Office Action that “it would have been obvious ... to utilize the teachings of ... so that the telephone owner can earn some profits and recoup losses from providing telephone service to telephone user” are insufficient as demonstrations of the suggestions or motivations to combine the references. In failing to satisfy the first criterion, the Office Action also failed to satisfy the

second criterion. The failure of the Office Action to satisfy the third criterion is demonstrated above in detail that the cited references fail to teach or suggest all of the claim limitations.

In light of the foregoing, it is submitted the pending claims are allowable and a Notice of Allowance is respectfully requested. If there are any issues that can be resolved via telephone conference, the Examiner is invited to contact the undersigned at 404.372.1430.

Respectfully submitted,

A handwritten signature in black ink, reading "Nora M. Tocups". The signature is fluid and cursive, with the first name "Nora" and last name "Tocups" clearly legible.

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